

REMARKS

Claims 1-55 are pending in the above-identified patent application. Claims 28-36 and 45-53 were withdrawn. No claims are substantively amended herein and no new matter is introduced.

Claims 1-33, 37-39, 41-43, 54 and 55 were rejected.

Claims 2-5, 19, 12-14, 19, 21-22 and 27 have been amended.

No new matter was added.

A. Restriction and Election

Claims 1-27, 37-44 and 54-55, drawn to a method for authenticating a textile material comprising applying a nucleic acid marker mixture to fibrous material, in class 427.

The Examiner has made the election of one of the following species FINAL.

- a) adding the nucleic acid mixture during bale opening;
- b) adding the nucleic acid mixture during knitting/weaving; or
- c) adding the nucleic acid mixture during dyeing.

Applicants have chosen to elect species b, without traverse.

B. 35 U.S.C. § 112, second paragraph

Claims 2-5, 12-14, 19, 21-22, and 27 were rejected under 35 U.S.C. § 112, second paragraph. The Examiner rejected claims 2-5, 12-14, 19, 21-22, and 27 as being indefinite for using improper Markush language. The Applicants have amended claims 2-5, 10, 12-14, 19, 21-22, and 27 to recite proper Markush language.

The Examiner additionally rejected claims 5, 14 and 22 for having no antecedent basis for "said plurality of products" in line 1 of each claim. The Applicants have amended claims 5, 14 and 22 to recite "a plurality of products." Applicants believe that the amendments to claims 2-5, 10, 12-14, 19, 21-22, and 27 overcome that 35 U.S.C. §112, second paragraph rejection.

The Applicants respectfully request that the §112, second paragraph rejection be withdrawn to the amendments to claims 2-5, 10, 12-14, 19, 21-22, and 27.

C. 35 U.S.C. § 103

The Examiner rejected claims 1-33, 37, 39, 41-43, and 54-55 under 35 U.S.C. §103(a) as being unpatentable over Rancien et al. (US 2004/0063117). Applicants respectfully point out that the Rancien et al. US publication No. 2004/0063117 is improperly cited as prior art against Applicants' claims.

At 706.02(f)(1)(C), the MPEP Examination Guidelines for Applying References Under 35 U.S.C. §102(e) state:

"(C) If the potential reference resulted from, or claimed the benefit of, an international application, the following must be determined:

(1) If the international application meets the following three conditions:

- (a) an international filing date on or after November 29, 2000;
- (b) designated the United States; and
- (c) published under PCT Article 21(2) in English."

Applicants note that MPEP 706.02(f)(1) further provides that

"(2) If the international application was filed on or after November 29, 2000, but did not designate the United States or was not published in English under PCT Article 21(2), do not treat the international filing date as a U.S. filing date for prior art purposes. In this situation, do not apply the reference as of its international filing date, its date of completion of the 35 U.S.C. 371(c)(1), (2) and (4) requirements, or any earlier filing date to which such an international application claims benefit or priority. The reference may be applied under 35 U.S.C. 102(a) or (b) as of its publication date, or 35 U.S.C. 102(e) as of any later U.S. filing date of an application that properly claimed the benefit of the international application (if applicable)."

The instant application has the priority date of provisional application No. 60/463,215, filed April 16, 2003. See the first sentence of Applicants' specification.

Support for the pending claims can be found throughout the specification, figure, and claims of the provisional application. Applicants' claims thus are entitled to the priority date of April 16, 2003.

Rancien et al. US publication No. 2004/0063117 was published on April 1, 2004 which is later than the instant application's priority date of April 16, 2003. Furthermore, Rancien et al. US 10/466,627 was filed in the US on July 18, 2003 which again is later than the priority date of the instant application. International Application No. PCT/FR02/00209 filed on January 18, 2002 was published in French (but not in English) on July 25, 2002, as WO2002057548. US publication No. 2004/0063117 thus is not entitled to the international filing date of January 18, 2002, for prior art purposes.

Accordingly, Rancien et al. does not meet the last criterion of MPEP 706.02(f)(1)(C), i.e., published under PCT Article 21(2) in English. US publication No. 2004/0063117 is valid as prior art only as of its publication date of April 1, 2004, which is later than the instant application's priority date of April 16, 2003.

Applicants request that the §103(a) rejection be withdrawn since the rejection is solely based on Rancien et al.

E. Conclusion

In view of all of the foregoing, Applicants believe that the pending claims are in condition for allowance.

Respectfully Submitted,

Dated: July 28, 2009



Michael A. Kerr

Michael A. Kerr, Reg. No. 42,722
VIRTUAL LEGAL, LLC
P.O. Box 22028
Carson City, NV 89721

Ph. 775-841-3388
Fx. 775-841-3389
mick@invent.net